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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Patisserie¹

Serial No. 76493247

James C. Wray of Law Offices of James C. Wray for The Patisserie.

Nicholas K.D. Altree, Trademark Examining Attorney, Law Office 108 (Andrew Lawrence, Managing Attorney).

Before Seeherman, Drost and Walsh, Administrative Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

On February 21, 2003, The Patisserie (applicant), through a predecessor, applied to register PARADISE LAVOSH in standard character form on the Principal Register for goods ultimately identified as "baked cracker bread and baked Armenian bread" based on an allegation of first use

¹ Serial No. 76493247 - Rolf F.M. Winkler, an individual and applicant at the time of filing, assigned the application to The Patisserie, a corporation of Hawaii, in a document recorded in the USPTO on May 28, 2004 at Reel 2981, Frame 0651.

of the mark and first use of the mark in commerce in 1990. The examining attorney refused registration under Section 2(d) of the Trademark Act. 15 U.S.C. § 1052(d). Applicant responded; the examining attorney issued a final refusal, and applicant appealed.²

Applicant seeks to register PARADISE LAVOSH in standard character form for "baked cracker bread and baked Armenian bread." Applicant has disclaimed "LAVOSH." The examining attorney has refused registration under § 2(d) based on a likelihood of confusion with the mark in Registration No. 2,404,157, PARADISE, also in standard character form, for "cakes." For reasons set forth more fully below, we affirm.

Section 2(d) of the Act precludes registration of an applicant's mark "which so resembles a mark registered in the Patent & Trademark Office . . . as to be likely, when

² In its brief applicant points out that in both the initial action and in the most recent Examiner's Amendment, the examining attorney included a standard search clause indicating that no conflicting marks were found. Applicant states, "As such, it appears that the Examining Attorney has withdrawn the Section 2(d) refusal." Applicant's Brief at 2. The examining attorney points out in his appeal brief that he advised the applicant in a telephone conversation leading to the issuance of the recent Examiner's Amendment that the Examiner's Amendment would have no effect on the substantive refusal. Examining Attorney's Appeal Brief at 1. The examining attorney also states that inclusion of the search clause was inadvertent and that he telephoned applicant's counsel and advised him of the inadvertent error and apologized. Id. at 2. In its reply brief applicant does not

used on or in connection with the goods of the applicant,
to cause confusion . . .” Id.

The opinion in In re E.I. du Pont de Nemours & Co.,
476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977) sets forth the
factors we may consider in determining likelihood of
confusion. In doing so the Court recognized that we decide
the issue case by case and that one factor may play a
dominant role in a particular case. Id. at 567. We
discuss below the factors relevant here.

Comparison of the Marks

We conclude that the marks of the registrant and
applicant, PARADISE on the one hand, and PARADISE LAVOSH on
the other, are highly similar. The marks are similar in
appearance, sound, meaning and commercial impression
because applicant’s mark begins with the same word,
PARADISE, that is the registrant’s entire mark and the
dominant and only distinctive element of both marks.
Applicant merely adds the generic term, LAVOSH, to the
registered mark.

Applicant argues that the marks differ in appearance,
sound and commercial impression. Applicant’s Brief at 2.

dispute this explanation. Accordingly, it is clear that the
refusal was not withdrawn.

Appearance - More specifically, applicant argues that PARADISE LAVOSH differs from PARADISE in appearance because it has two words and fourteen letters and because the second word, LAVOSH, "draws the majority of the attention and emphasis." Id. at 3. Applicant also argues that LAVOSH is "arbitrary and unique." Id. On the other hand, the examining attorney argues that the marks are similar. While acknowledging that the marks must be considered in their entirety, the examining attorney argues that certain elements may be more significant or dominant and that "generic matter that is disclaimed is less significant when comparing marks" citing In re Dixie Restaurants, Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) and other cases.

The record indicates that LAVOSH is a generic term for applicant's goods. The examining attorney attached to the final refusal an excerpt from the web page of "EPICURIOUS - THE WORLD'S GREATEST RECIPE COLLECTION" which includes the following definition:

Lahvosh; lovosh
[LAH-vohsh]

A round, thin, crisp bread that is also known as *Armenian cracker bread*. It comes in a soft version, as well as various sizes, ranging from about 6 to 14 inches in diameter. Lahvosh is available in Middle Eastern Markets and most supermarkets. It's the bread used to make the popular ARAM SANDWICH.

Applicant's specimen confirms that LAVOSH is a generic term. The specimen states:

Today, shepherds in the rugged highlands of Armenia still make their bread the very old way. They call it Lavosh, which means "Forever Crispy."

Since 1975 Lavosh has appeared on the dining tables of Hawaii's finest restaurants and homes. It is a popular replacement for heavier slices of bread - For gourmets it's a real taste treat, and for the younger set, it's a great snack between meals. . .

Applicant agreed to disclaim "LAVOSH" without argument, and applicant has not disputed the examining attorney's characterization of LAVOSH as generic.

Applicant's argument that LAVOSH is "arbitrary and unique" is not supported by the record as illustrated by the definition the examining attorney provided.

Applicant's arguments based on a comparison of the number of letters or words in the respective marks are also unpersuasive.

To complete the discussion of the appearance of the marks, we note the examining attorney's contention that the display of applicant's mark on the specimen supports the conclusion that PARADISE is the dominant element in applicant's mark. The specimen shows PARADISE above an oval design with the words "FRESH MADE IN HAWAII" displayed within the oval and LAVOSH beneath the oval. PARADISE and

LAVOSH are displayed in the same script and they are similar in size. The examining attorney contends that the separation of the two words in applicant's mark demonstrates that PARADISE is the dominant element. Examining Attorney's Brief at 3. Applicant counters by stating, "However, this is merely because the first word comes first. The second word, LAVOSH, must necessarily come underneath the first word when displayed on the specimen." Applicant's Brief at 3. Because the application presents the mark in standard character form, the application is not limited to the display in the specimen. The specimen does illustrate that the mark could be displayed in a manner where the relative positioning of the words subordinates LAVOSH to PARADISE, and thereby reinforces the dominance of PARADISE. However, our determination that PARADISE is dominant is not based on this or any other particular display, but rather the order and inherent character of the two words.

In a recent case the Court of Appeals for the Federal Circuit considered whether VEUVE ROYALE was confusingly similar to VEUVE CLICQUOT and concluded, "The presence of this strong distinctive term as the first word in both parties' marks renders the marks similar, especially in light of the largely laudatory (and hence non-source

identifying) significance of ROYALE." Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). The facts of this case are strikingly similar and dictate the same conclusion.

Accordingly, we conclude that the marks are highly similar in appearance. Both marks are in standard character form. Both marks begin with PARADISE. Applicant only adds the generic term LAVOSH. The mere addition of a generic term to the registered mark is normally insufficient to distinguish the marks. PARADISE, the sole distinctive element, is the dominant element in both marks. Id., 73 USPQ2d at 1692; In re Dixie Restaurants, Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); In re Infinity Broadcasting Corp. of Dallas, 60 USPQ2d 1214, 1217 (TTAB 2001); In re N.A.D. Inc., 57 USPQ2d 1872, 1873 (TTAB 2000).

Sound - Applicant also argues that the marks sound different, again because applicant's mark includes the additional word LAVOSH. We find this argument unpersuasive. The variation in sound resulting from the mere addition of a generic term is not normally sufficient to distinguish the marks. There is no support for and we must reject applicant's further contention that, "The

emphasis during speech is on the second word, LAVOSH."

Applicant's Brief at 4.

Meaning and Commercial Impression - Applicant also argues that the commercial impressions differ due to the addition of the generic term LAVOSH to applicant's mark. Applicant implies that the impression or meaning PARADISE projects is somehow altered by the addition of LAVOSH. Id. We fail to see how the addition of LAVOSH in any way alters the meaning of PARADISE or otherwise affects the overall impression engendered by both marks. "Paradise" conveys the same meaning and impression in both marks. Applicant's characterization of the meaning as - "a perfect location" - captures the meaning and commercial impression of both marks. Applicant's brief at 4.

Accordingly, we conclude that the marks are highly similar in appearance, sound, meaning and commercial impression.

Comparison of the Goods

We also conclude that the goods of the applicant and registrant, "baked cracker bread and baked Armenian bread" on the one hand, and "cakes" on the other, are related.

Applicant argues throughout its brief that the goods are "completely different" and that "No consumer would confuse sweet tasting cake with crispy flat bread."

Applicant's Brief at 4. We must dismiss any argument that "the goods" could not be confused. The proper inquiry is not whether the goods could be confused, but rather whether the source of the goods could be confused. Safety-Kleen Corp. v. Dresser Indus., Inc., 518 F.2d 1399, 186 USPQ 476, 480 (CCPA 1975); In re Rexel, Inc., 223 USPQ 830, 831 (TTAB 1984). Applicant's arguments with respect to the goods, apart from the channels of trade, do not address the source issue and must be disregarded.

The examining attorney argues that the goods are related and presents third-party registrations to show that the same mark has been registered for both types of goods. For example: Registration No. 2,808,618 for THE FAMILY'S CAKE COMPANY, INC. claims use on both breads and cakes and other goods; Reg. No. 2,801,634 for PAKULA'S BAKERY claims use on both cakes and breads, and other goods, Reg. No. 2,799,203 for FTO claims use on both breads and cakes, and other goods; and Reg. No. 2,702,732 for TROPICAL FLOUR claims use on both breads and cakes, and other goods. These registrations, and the others submitted by the examining attorney, though of limited probative value, do suggest that the goods are of a type which may emanate from the same source. In re TSI Brands Inc., 67 USPQ2d 1657, 1659 (TTAB 2002); In re Albert Trostel & Sons Co., 29

USPQ2d 1783, 1785-86 (TTAB 1993). The registrations, in fact, show that a single mark has been registered for a variety of baked goods; the fact that "Armenian cracker bread" or "lavosh" is not specifically listed in no way detracts from their value in this regard. Furthermore, we have previously found other food items related to baked goods and different types of baked goods related to one another in similar circumstances. See, e.g., In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984); In re Pan-O-Gold Baking Co., 20 USPQ2d 1761, 1765 (TTAB 1991); Robert A. Johnston Co. v. Ward Foods, Inc., 157 USPQ 204, 206 (TTAB 1968); In re Continental Baking Co., 147 USPQ 333, 333-334 (TTAB 1965), aff'd, 156 USPQ 514 (CCPA 1968). Accordingly, we conclude that the goods of applicant and registrant are related.

Comparison of the Channels of Trade

Applicant's principal arguments with respect to the goods relate to the channels of trade. Again, throughout its brief applicant states:

The cakes of the cited registration would not be sold near the Applicant's goods. Applicant's goods are sold in separate stores and areas of stores. The goods of the cited registration would be sold in

specialty bakeries or a cake section of a grocery store, and not in stores for ethnic novelty breads.

Applicant's Brief at 5.

Applicant's arguments presume limitations in trade channels not specified in either its application or the cited registration. An applicant may not restrict trade channels beyond what is specified in the application or registration by extrinsic argument or evidence. In re Bercut-Vandervoort & Co., 229 USPQ2d 763, 764 (TTAB 1986). We must look to the goods and services as identified in the application and registration in determining likelihood of confusion. CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991). In the absence of explicit restrictions we must presume that the application or registration covers all goods of the type described and that those goods travel in all trade channels typical for those goods and that the goods are available to all typical classes of purchasers for those goods. Id.

Here we must assume that "cakes" could include all types of cakes, including cakes based on ethnic or specialty recipes. Likewise we must presume that the "cakes" would be sold through all normal channels for such goods, including, among other channels, bakeries, specialty

food stores and supermarkets. The examining attorney's evidence and, in particular, the definition of "LAVOSH" provided above, indicates that goods of the type the applicant identifies in its application, "baked cracker bread and baked Armenian bread" would be sold in "Middle Eastern Markets and most supermarkets." Applicant has not disputed the accuracy of this statement. Applicant's contention that the goods may be found in different sections or on different shelves within the same stores is without any support. Confusion may be likely even if the goods of applicant and registrant are not displayed in the same store section or on the same shelf. In re Martin's Famous Pastry Shoppe, Inc., supra, 223 USPQ at 1290.

Accordingly, we conclude that the goods of applicant and registrant move in the same or overlapping trade channels.

"Impulse" vs. Careful, Sophisticated Purchasing

With regard to purchaser sophistication, applicant argues as follows:

The purchasers of Applicant's traditional cracker breads are highly sophisticated purchasers that will readily recognize the Applicant's name. Applicant's goods are food items that would require a consumer to exercise a high degree of care with considerable research expended into the source of the goods. Nobody looking for the cakes of the cited registration

would mistakenly buy the Applicant's Armenian flat bread.

Applicant's Brief at 5.

We had previously rejected the argument with regard to confusion as to the goods rather the source of the goods. As to purchaser sophistication, again applicant offers no support for its contention that the purchasers for its goods are sophisticated. Contrary to applicant's assertion, the Federal Circuit has observed, "bread and cheese are staple, relatively inexpensive comestibles subject to frequent replacement. Purchasers of such products have long been held to a lesser standard of purchasing care." In re Martin's Famous Pastry Shoppe, Inc., supra, 223 USPQ at 1290 (citations omitted). The goods at issue here are inexpensive items which would typically be purchased without a great deal of deliberation or care. Accordingly, we conclude that the purchasers of the products of applicant and registrant are not sophisticated.

Fame

Applicant points out that the mark in the cited registration is neither famous nor well known. Applicant's Brief at 6. In the absence of any evidence of fame, we agree. However, the absence of fame in no way bolsters

applicant's case. In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003)("\. . . we decline to establish that the converse rule that likelihood of confusion is precluded by a registered mark's not being famous."). The fame factor does not enter into our determination in this case.

Similar Marks In Use on Similar Goods

Although applicant does not identify it as such applicant presents arguments addressing the sixth du Pont factor, that is, "The number and nature of similar marks in use on similar goods." du Pont, supra, 177 USPQ at 567. In its response to the first office action applicant indicated that it found 37 current registrations in Class 30 in the USPTO data base which included PARADISE in the mark. Applicant provided a listing of those registrations; the listing included only the application serial numbers, registration numbers, the marks and the status, that is, an indication as to whether the record was "live" or "dead." "Mere listings of registrations or copies of private company search reports, are not sufficient to make the registrations of record." TBMP § 1208.02 (2d ed. rev. 2004)(citations omitted). The examining attorney has not explicitly objected to these. However, as a practical matter, because these records do not include any

information with regard to the goods and services, nor any ownership information, they are of extremely limited probative value.

With his final refusal, the examining attorney included copies of three USPTO registration records in acceptable electronic form from the 37 in applicant's listing. In that action, the examining attorney represented that these three registrations were the only records of the 37 which included "cakes" or "bread" in the identifications of goods. The registrations are: Reg. No. 2,820,363 for TASTE PARADISE for "bread, loaf bread, bread pudding, bread sticks, sliced bread, coffee cakes, bread rolls, cluster rolls, individual rolls, sandwich rolls, hoagie rolls, foccacia sandwich rolls, sweet rolls and filled rolls (in Class 30); Reg. No. 1,968,213 for PARADISE FARM ORGANICS for organically grown produced processed grains, rice processed herbs and spices, cereal flours, bread, pancake and muffin mixes, granola-based breakfast cereal and hot cereal mixes, rice pilaf, couscous, barley coffee substitute, honey table syrups and chocolate powder (in Class 30); and Reg. No. 627,487 for BIRD OF PARADISE for cakes (in Class 30). These registrations are of some probative value in determining the extent to which similar marks may be in use on similar goods. With regard to these

registrations, in his final action the examining attorney states, ". . . these three registrations create distinct commercial impressions and therefore do not dilute the significance of the term PARADISE when used in connection with the goods at issue in this case." Final Action at page 2. We agree. There is no evidence suggesting that PARADISE is a weak mark for the goods at issue here.³ In re Melville, supra at 1389. Furthermore, the registration of marks in prior applications does not bind us here. In re Nett Designs, Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

Lastly, in its brief applicant provides a somewhat detailed attempt to distinguish the various cases cited by the examining attorney on the facts and otherwise. To the extent we have not discussed those cases elsewhere we note that we have considered applicant's arguments in this regard and found them unpersuasive. In the final analysis we must consider each case on its own facts and merits, as we have done here. In re Melville, supra at 1389.

³ Applicant also argues that the examining attorney's withdrawal of a potential objection based on a pending application for PARADISE DONUTS indicates that its application too should be approved. Reply Brief at 1. According to the only information of record with regard to Application Serial No. 78151955 for PARADISE DONUTS attached to the examining attorney's first action, the goods and services are identified as, "cafes featuring donuts for consumption on the premises" in Class 43. This too fails to show that PARADISE is a weak mark.

Furthermore, we must resolve any doubt in favor of the prior registrant. In re Martin's Famous Pastry Shoppe, Inc., supra, 223 USPQ at 1290.

In conclusion, based on our consideration of all evidence of record bearing on the du Pont factors we conclude that there is a likelihood of confusion. Most importantly, the marks of the parties are highly similar because the dominant and only distinctive element in each mark is PARADISE and the only additional element is the disclaimed, generic term LAVOSH in applicant's mark. The goods of the parties are related. "Cakes" and "baked cracker bread and baked Armenian bread" are related types of baked goods which would travel in the same or overlapping trade channels.

Decision: The refusal to register applicant's mark on the ground of a likelihood of confusion is affirmed.